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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,098	11/27/2000	Modasser El-Shoubary	13093	5348

7590 08/27/2002

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New York, NY 10022

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

9

DATE MAILED: 08/27/2002

Please find below and or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

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Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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DATE MAILED:

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

**ADVISORY ACTION**

**THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☒ they raise the issue of new matter. (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

**NOTE:**

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment f
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-3f
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): 7
11. ☐ Other: \_\_\_\_\_

*Tae H. Yoon*  
TAE H. YOON  
PRIMARY EXAMINER

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### **ATTACHMENT TO ADVISORY ACTION**

The amended claims raise new issues that would require further consideration and search. The recited "inorganic oxide" has no support in the originally filed specification and constitutes NEW MATTER. Thus, the entry of the amendment is denied.

The original claim 4 and the disclosure on page 4, lines 6-8 cannot support said "inorganic oxide" since only titanium oxide (specie) is considered "inorganic oxide" (genus). For example, kaolin, talc, mica and calcium carbonate are not inorganic oxides absent any definition in the originally filed specification. Thus, it also raise new issue under 112, first paragraph rejection. Also, new claim 53 with limitation of an amount of the organo-acid phosphate compound in a polymer raises new issue that would require further consideration at least. Note that no previous claims either single (independent claims) or combination (dependent claims) had such limitation.

Again, the examiner's position is that the ball milling process of the prior art meets the instant invention absent any pigment particle size. Applicant asserts that the ball milling would yield a size of 0.3 mm, not below 50 micrometers in size. However, said "below 50 micrometers in size" is nowhere in originally filed specification, and thus lacks any probative value.

The examiner will not repeat reasoning for the rejections based on DE1234234, US 5,397,391 and US 5,466,482 since the entry of the amendment is denied.

With respect to US 5,876,493, applicant asserts that claim 34 would be patentable. But, the examiner disagrees since US 5,876,493 teaches the instant claim 34 at col. 1, lines 46-57 and col. 4, lines 6-10.

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With respect to US 5,466,482, US 5,876,493 teaches the collection of the treated pigment by centrifugation at col. 4, lines 41-44. Thus, the use of any grinding or separation method of a centrifuged cake or bulk) is an inherent or at least obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/August 26, 2002



TAE H. YOON  
PRIMARY EXAMINER